

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Yamamoto et al.
Appl. No.	:	10/618,957
Filed	:	July 14, 2003
For	:	SURFACE PROTECTIVE FILM FOR TRANSPARENT CONDUCTIVE SUBSTRATE, AND TRANSPARENT CONDUCTIVE SUBSTRATE WITH SURFACE PROTECTIVE FILM
Examiner	:	Chang, Victor S.
Group Art Unit	:	1794

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejections of the claim in the non-final Office Action of June 3, 2009 for the above-identified application. No amendments are being filed with this request.

Enclosed with this Request is a Notice of Appeal.

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REASONS FOR REQUEST

Review of the above-identified application is requested for the following reasons:

There are Clear Errors in the Examiner's Rejection Under 35 U.S.C. §103

Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. §103 as being obvious over JP 09-151360 in view of Masuda (U.S. Pat Pub 2002/0064650).

The Examiner asserts that JP 09-151360 teaches a transparent film comprising an adhesive layer on one side and an antistatic layer on the other side. The Examiner asserts that Masuda teaches a polymer containing pyrrolidinium rings, and it would have been obvious to use Masuda's polymer in the film of JP 09-151360. The Examiner asserts that the recited transparency after heat treatment would be "inherent to the same chemistry as the present invention." *Office Action* at page 4.

There are clear errors in the Examiner's rejection because the Examiner's proposed modification to JP 09-151360 is contrary to the teaching of JP 09-151360, because there is insufficient evidence to assert that the recited transparency under heat treatment would be inherently present, and because it is improper to combine the cited references.

The Proposed Modification of JP 09-151360 is Contrary to the Teachings of JP 09-151360

JP 09-151360 teaches that the object of the invention is to prepare a film with an antistatic layer that is able to maintain high transparency over a long period of use. *See JP 09-151360* at Abstract and paragraph [0005]. JP 09-151360 teaches that these goals are achieved by using a needle crystal of tin oxide doped with antimony oxide (referred to as "needle crystal tin oxide") as the antistatic agent. *See JP 09-151360* at Abstract and paragraphs [0006] and [0015]. That is, the key improvement in the invention of JP 09-151360 is the use of needle crystal tin oxide as an antistatic agent that also "dramatically" improves transparency. *See JP 09-151360* at paragraph [0017]. As such, removing needle crystal tin oxide from the film would remove the key improvement to the invention of JP 09-151360, and would render the invention of JP 09-151360 unsatisfactory for its intended purpose. Therefore, modification of JP 09-151360 to remove needle crystal tin oxide from the film would be contrary to the teachings of JP 09-151360. As

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such, modification of JP 09-151360 to remove needle crystal tin oxide from the film would be non-obvious over JP 09-151360. Thus, the Examiner's rejection based on the above modification of JP 09-151360 is clearly erroneous and should be removed.

The Examiner's Assertion of Inherency is Erroneous

Furthermore, the Examiner's rejection contains clear error because there is insufficient basis to assert that the recited transparency under heat treatment would be inherently present. Claims 8 and 14 recite that the claimed film is configured to maintain transparency even after one-hour heat treatment at 150°C. As discussed above, modification of JP 09-151360 to remove needle crystal tin oxide from the film would be contrary to the teachings of JP 09-151360. Accordingly any modified film must include needle crystal tin oxide in order to be consistent with the teachings of JP 09-151360. However, there is insufficient evidence of record to support an assertion that a film containing needle crystal tin oxide would maintain transparency even after one-hour heat treatment at 150°C. The Examiner asserts that the proposed combination of JP 09-151360 and Masuda would inherently maintain transparency even after one-hour heat treatment at 150°C because this combination would have "the same chemistry as the claimed invention." *Office Action* at page 4. However, a film containing needle crystal tin oxide in the antistatic layer would not have "the same chemistry as the claimed invention." Therefore, the Examiner's basis for asserting inherency is inapplicable to a film containing needle crystal tin oxide in the antistatic layer. There is no evidence that a film containing needle crystal tin oxide in the antistatic layer would necessarily maintain transparency even after one-hour heat treatment at 150°C. Both JP 09-151360 and Masuda are silent regarding elevated temperatures. As such, neither reference provides any evidence that a film containing needle crystal tin oxide in the antistatic layer would necessarily maintain transparency even after one-hour heat treatment at 150°C.

To establish inherency, the evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. The Examiner fails to provide evidence that makes clear that the recited transparency after one-hour heat treatment is necessarily present in the proposed combination of the

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references. As such, there is insufficient evidence to demonstrate that the recited transparency after one-hour heat treatment is inherently present. Accordingly, the Examiner's rejection is clearly erroneous for failing to establish that the combination of the references teaches all elements of the claims.

The References Teach Away From Their Combination

Furthermore, the Examiner's rejection contains clear error because references teach away from their combination. As described above, JP 09-151360 teaches the importance of maintaining high transparency. In contrast, to JP 09-151360, the object of Masuda's invention is to provide a film having excellent light-shielding effect, good coating and adhesive properties with hard coating materials and pastes (sticking agents and adhesives), and capable of long-time use as a light-shielding film for windows. *Masuda* at paragraph [0009]. Masuda teaches that it is essential that the film of Masuda include a dye such that the film's visible light transmittance is 3 to 70%, preferably 5 to 50%. *Masuda* at paragraph [0019]. Thus, Masuda's invention is directed to a film whose primary and essential feature is excellent light-shielding effect. In an obviousness rejection, it is improper to combine references where the references teach away from their combination. JP 09-151360 teaches the importance of maintaining high transparency, while Masuda teaches the importance of light shielding. It would be improper to combine a reference that teaches the importance of maintaining high transparency with a reference that teaches the importance of light shielding. As such, it would be improper to combine JP 09-151360 with Masuda in rejecting the claims as being obvious. Thus, the Examiner's rejection based on the above combination of JP 09-151360 with Masuda is clearly erroneous and should be removed.

The Rejection of Claim 19 is Further Erroneous

The rejection of Claim 19 is further erroneous because no combination of the references teaches the elements recited in Claim 19. Claim 19 recites that the adhesive layer comprises a co-polymer containing 0.1 through 12 percent by weight of monomers having functional groups selected from carboxyl groups, hydroxyl groups, epoxy groups and amino groups. The Examiner states that JP 09-151360 teaches an ester group, which contains both a carboxyl group and a hydroxyl group. However, it is well-known in the art that an ester group is neither a carboxyl group

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nor a hydroxyl group, but is different than both. Thus, JP 09-151360 does not teach carboxyl group or a hydroxyl group, or any other group recited in Claim 19. Accordingly, no combination of the references teaches all elements of Claim 19. Thus, the Examiner's rejection of Claim 19 is clearly erroneous and should be removed.

The Rejection of Claim 20 is Further Erroneous

The rejection of Claim 20 is further erroneous because Masuda teaches away from Claim 20. Claim 20 recites that the transparent base material film is a single-layer film. In contrast, Masuda teaches that it is important for the film of Masuda to contain "at least three laminated polyester layers." *Masuda* at paragraph [0015]. Thus, Masuda teaches avoiding a single-layer film as recited in Claim 20. Therefore, Masuda serves as evidence of the non-obviousness of the claims. Accordingly, the Examiner's rejection of Claim 20 is clearly erroneous and should be removed.

CONCLUSION

The rejection of the claims is clearly erroneous and must be reversed. Accordingly, the claims are in condition for allowance.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 3, 2009

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